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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH A. PARULSKI

Appeal 2008-2982
Application 09/534,471
Technology Center 3600

Decided: December 11, 2008

Before ANTON W. FETTING, DAVID B. WALKER, and JOHN C. KERINS, Administrative Patent Judges.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Kenneth A. Parulski (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection of claims 1-6 and 9-19, the only claims pending in the application on appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
2 (2002).

3
4 We AFFIRM-IN-PART.

5 The Appellant invented a configured camera system and a method that
6 uses the Internet to lease such configured camera systems (Specification
7 1:13-15).

8 An understanding of the invention can be derived from a reading of
9 exemplary claims 1 and 17, which are reproduced below [bracketed matter
10 and some paragraphing added].

11 1. A method for a customer leasing a configured camera system
12 including a camera and services for using such configured
13 camera system and paying for the lease of such configured
14 camera system, comprising the steps of:

15 (a) providing an electronic database of information
16 describing a plurality of differently configured camera systems
17 which have different features and services that can be selected
18 by the customer via a digital communications network;

19 (b) displaying at the customer's location remote from the
20 electronic database various components of the camera system
21 that can be combined into the configured camera system;

22 (c) the customer selecting desired components and services
23 to provide the configured camera system and completing a lease
24 agreement and providing a payment identifier specifying an
25 account to be debited to pay for the configured camera system;
26 and

27 (d) sending the camera to a designee of the customer and
28 establishing a service user account that specify the selected
29 services that the designee can use with respect to the images
30 captured by said camera.

31
32 17. A camera for capturing images to be provided to a service
33 provider, comprising:

34 (a) means for capturing and storing images;

8 This appeal arises from the Examiner's Final Rejection, mailed
9 January 13, 2003. The Appellant filed an Appeal Brief in support of the
10 appeal on April 13, 2007. An Examiner's Answer to the Appeal Brief was
11 mailed on September 17, 2007. A Reply Brief was filed on October 25,
12 2007.

PRIOR ART

14 The Examiner relies upon the following prior art:

REJECTIONS

19 Claims 17-19 are rejected under 35 U.S.C. § 102(b) as anticipated by
20 Kitagawa.

21 Claims 1-6 and 9-16 are rejected under 35 U.S.C. § 103(a) as
22 unpatentable over the Admitted Prior Art in view of Kitagawa.

ISSUES

25 The issues pertinent to this appeal are

26 • Whether the Appellant has sustained its burden of showing that the
27 Examiner erred in rejecting claims 17-19 under 35 U.S.C. § 102(b) as
28 anticipated by Kitagawa.

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-6 and 9-16 under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art in view of Kitagawa.

The pertinent issues turn on whether Kitigawa identically discloses limitations [b] and [c] of claim 17 and whether the Admitted Prior Art and Kitigawa disclose limitations [a-d] of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of the term “lease.”
02. The ordinary and customary meaning of “lease” is “to grant use or occupation of under the terms of a contract.”¹

Facts Related to Appellant's Disclosure (Admitted Prior Art)

03. Dell's website enables a user to configure or customize a computer by selecting various options (Specification 2:1-6).
04. Dell's website allows a user to order selected equipment, including customized or configured equipment, over the Internet (Specification 2:9-11).
05. A "learn more" link for each option for an advertised product on Dell's website provides a detailed description of the options a user can select (Specification 2:4-6).

06. Bestcameras.com describes ordering single use cameras (Specification 3:1-6).

Kitagawa

07. Kitagawa teaches a method for recording photographic data while using a photo capturing device (Kitagawa col. 1 ll. 6-7).

08. Kitagawa teaches capturing and recording photographic images into memory (Kitagawa col. 9, ll. 9-10 and figure 5).

09. The IC memory includes fundamental data including unit ID, date of manufacture, flash data, print format data, and clock pulse number data (Kitagawa col. 9, ll. 30-33).

10. The camera with film is forwarded to a photo-lab, the data in the IC memory is read and transferred to the magnetic recording surface of the film, photographic images printed at the photo-lab and returned back to the customer/photographer at a photo-shop (Kitagawa col. 7, ll. 66-67, col. 8 ll. 1-30, col. 12, ll. 14-17, and col. 12, ll. 26-28).

Facts Related To The Level Of Skill In The Art

11. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts of data recording in photography. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”)

¹ *American Heritage Dictionary of the English Language* (4th ed. 2000).

(quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

12. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

9 During examination of a patent application, pending claims are
10 given their broadest reasonable construction consistent with the
11 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
12 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

13 Limitations appearing in the specification but not recited in the claim
14 are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d
15 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
16 specification” without importing limitations from the specification into the
17 claims unnecessarily).

18 Although a patent applicant is entitled to be his or her own
19 lexicographer of patent claim terms, in *ex parte* prosecution it must be
20 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant
21 must do so by placing such definitions in the Specification with sufficient
22 clarity to provide a person of ordinary skill in the art with clear and precise
23 notice of the meaning that is to be construed. *See also In re Paulsen*, 30
24 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the
25 specific terms used to describe the invention, this must be done with
26 reasonable clarity, deliberateness, and precision; where an inventor chooses

1 to give terms uncommon meanings, the inventor must set out any
2 uncommon definition in some manner within the patent disclosure so as to
3 give one of ordinary skill in the art notice of the change).

4

5 *Claim Preamble*

6 “[A] claim preamble has the import that the claim as a whole suggests
7 for it.” *Bell Communications Research, Inc. v. Vitalink Communications*
8 *Corp.*, 55 F.3d 615, 620 (Fed.Cir. 1995). If the claim preamble, when read
9 in the context of the entire claim, recites limitations of the claim, or, if the
10 claim preamble is “necessary to give life, meaning, and vitality” to the
11 claim, then the claim preamble should be construed as if in the balance of
12 the claim. *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). “If, however,
13 the body of the claim fully and intrinsically sets forth the complete
14 invention, including all of its limitations, and the preamble offers no distinct
15 definition of any of the claimed invention’s limitations, but rather merely
16 states, for example, the purpose or intended use of the invention, then the
17 preamble is of no significance to claim construction because it cannot be
18 said to constitute or explain a claim limitation.” *Pitney Bowes, Inc. v.*
19 *Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

20

21 *Anticipation*

22 “A claim is anticipated only if each and every element as set forth in the
23 claim is found, either expressly or inherently described, in a single prior art
24 reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
25 631 (Fed. Cir. 1987). “When a claim covers several structures or
26 compositions, either generically or as alternatives, the claim is deemed

1 anticipated if any of the structures or compositions within the scope of the
2 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
3 Cir. 2001). "The identical invention must be shown in as complete detail as
4 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
5 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
6 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
7 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

8

9 *Obviousness*

10 A claimed invention is unpatentable if the differences between it and
11 the prior art are "such that the subject matter as a whole would have been
12 obvious at the time the invention was made to a person having ordinary skill
13 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.
14 Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14
15 (1966).

16 In *Graham*, the Court held that the obviousness analysis is bottomed
17 on several basic factual inquiries: "[1] the scope and content of the prior art
18 are to be determined; [(2)] differences between the prior art and the claims at
19 issue are to be ascertained; and [(3)] the level of ordinary skill in the
20 pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*,
21 127 S. Ct. at 1734. "The combination of familiar elements according to
22 known methods is likely to be obvious when it does no more than yield
23 predictable results." *KSR*, at 1739.

24 "When a work is available in one field of endeavor, design incentives
25 and other market forces can prompt variations of it, either in the same field

1 or a different one. If a person of ordinary skill can implement a predictable
2 variation, § 103 likely bars its patentability.” *Id.* at 1740.

3 “For the same reason, if a technique has been used to improve one
4 device, and a person of ordinary skill in the art would recognize that it would
5 improve similar devices in the same way, using the technique is obvious
6 unless its actual application is beyond his or her skill.” *Id.*

7 “Under the correct analysis, any need or problem known in the field
8 of endeavor at the time of invention and addressed by the patent can provide
9 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

10

11 ANALYSIS

12 *Claims 17-19 rejected under 35 U.S.C. §102(b) as anticipated by Kitagawa*

13 The Appellant argues these claims as a group.

14 Accordingly, we select claim 17 as representative of the group.

15 37 C.F.R. § 41.37(c)(1)(vii) (2007).

16 The Examiner found that Kitagawa describes all of the limitations of
17 claim 17 and thus Kitagawa anticipates the present invention (Answer 4-5).

18 The Appellant contends that:

- 19 1. Kitagawa fails to teach firmware for storing a service identifier
20 (Br. 6, first paragraph).
- 21 2. Kitagawa fails to teach that the service identifier identifies a
22 service provider *account* (Br. 6, first paragraph and second
23 paragraph).
- 24 3. Kitagawa fails to teach a means for providing the captured
25 images and the service identification to the service provider (Br.
26 6, first paragraph).

1 We disagree with the Appellant. First, it is uncontested that limitation
2 (a) in claim 17 is described by Kitagawa (FF 08).

3 The Appellant broadly contends that Kitagawa fails to describe a
4 firmware for storing a service identifier and a means for providing the
5 captured images and the service identification to the service provider (Br. 6,
6 first paragraph). We are not persuaded by this argument. Kitagawa
7 describes an IC memory, which is a firmware memory that actually stores a
8 unit identifier, and is therefore capable of storing information including a
9 service identifier (FF 08 and 09). Kitagawa further describes forwarding the
10 camera with film to a photo-lab and the film contains identification
11 information that has been transferred from the IC memory (FF 10).

12 The Appellant further argues that Kitagawa fails to describe a service
13 provider account (Br. 6, first and second paragraph). The Examiner
14 responds by contending that the purpose for which the memory will be used
15 (i.e., storing a service identifier which identifies a service provider account)
16 is merely an intended use (Answer, page 7, last full paragraph) and does not
17 result in a structural difference between the present invention and Kitagawa.
18 We agree with the Examiner. Claim 17 recites an apparatus and thus the
19 intended use must result in a structural difference between the present
20 invention and the camera system described by Kitagawa. The only
21 structural limitation regarding the firmware memory in claim 17 is that it be
22 capable of storing an identifier, not the use to which the memory contents
23 might be put.

24 "[E]xpressions relating the apparatus to contents thereof during an
25 intended operation are of no significance in determining patentability of the
26 apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

1 Furthermore, "inclusion of the material or article worked upon by a structure
2 being claimed does not impart patentability to the claims." *In re Otto*, 312
3 F.2d 937, 940 (CCPA 1963).

4 The Appellant has not sustained its burden of showing that the
5 Examiner erred in rejecting claims 17-19 under 35 U.S.C. § 102(b) as
6 unpatentable over Kitagawa.

7

8 *Claims 1-6 and 9-16 rejected under 35 U.S.C. §103(a) as unpatentable over*
9 *Admitted Prior Art in view of Kitagawa*

10 The Appellant argues these claims in four groups:

11 Group II: Claim 1
12 Group III: Claims 2-3
13 Group IV: Claims 4-6 and 16
14 Group V: Claims 9-15

15

16 *Group II*

17 The Examiner found that the Admitted Prior Art, as exemplified by
18 the Dell.com and Bestcameras.com web site discussions found in the
19 Specification, taught all of the limitations of claim 1 except that the items
20 being sold were not customized camera systems (Answer 5-6). The
21 Examiner found that Kitagawa cured this deficiency, pointing out that
22 Kitagawa taught offering customized camera systems, and further found that
23 it would have been obvious to combine Kitagawa with the Admitted Prior
24 Art in order for a company selling one-time use cameras to increase its
25 profits by reaching a wider market while satisfying a range of specific
26 market niches (Answer 6).

27 The Appellant contends that:

1. The Admitted Prior Art fails to describe uploading personal
2. data or digital images that are used to personalize the computer
3. or the merchandise and thus the information provided is not for
4. establishing what services are provided (Br. 7, first paragraph).
5. 2. The Admitted Prior Art fails to describe a camera designed to
6. capture images and the captured images are used for producing
7. image products such as photographic prints (Br. 7, second
8. paragraph).
9. 3. The Admitted Prior Art and Kitagawa fail to describe leasing a
10. camera (Br. 7 third paragraph and Br. 8, second paragraph).
11. 4. The Admitted Prior Art and Kitigawa fail to describe providing
12. a payment identifier that specifies an account to be debited for
13. the payment of the configured camera system (Br. 8, first
14. paragraph).
15. 5. The Admitted Prior Art and Kitigawa fail to describe sending of
16. the camera to a designee of the customer and establishing a
17. service user account as specified as selected services that the
18. designee can use with respect to the images captured by the
19. camera (Br. 8, first paragraph).
20. 6. There is no motivation to combine the Admitted Prior Art and
21. Kitagawa (Br. 9, first paragraph).

22. We will not sustain this rejection, for the reasons set forth *infra*. We
23. will consider the Appellant's arguments that are pertinent to the analysis of
24. claim 2 in the analysis of that claim following below.

25. With respect to "establishing a service user account that specify [sic.]
26. the selected services that the designee can use with respect to the images

1 captured by said camera,” we agree with the Appellant that the prior art is
2 deficient. The Examiner has failed to make a finding that this feature is
3 described in the Admitted Prior Art. We do not see any description in the
4 Admitted Prior Art or Kitagawa of this claim feature. We therefore find the
5 Examiner has failed to make a *prima facie* case of obviousness as to claim 1.

6 The Appellant has sustained his burden of showing that the Examiner
7 erred in rejecting claim 1. We reverse the Examiner’s rejection of claim 1.

8

9 *Group III*

10 The Appellant argues claims 2 and 3 as a group. Accordingly, we
11 select claim 2 as representative of the group. The Examiner rejected claim 2
12 for the reasons set forth in the rejection of claim 1. The Appellant contends
13 that claim 2 is distinguished from claim 1 because it additionally recites the
14 feature of selecting programs which depict the functionality of the desired
15 services. The Appellant contends that the neither the Admitted Prior Art nor
16 Kitagawa describe this feature (Br. 10, first incomplete paragraph).

17 We disagree with the Appellant. First we take up the arguments from
18 claim 1 that pertain to claim 2.

19 The Appellant contends that the Admitted Prior Art and Kitagawa fail
20 to describe leasing a camera (Br. 7, third paragraph and Br. 8, second
21 paragraph). We disagree with the Appellant. Claim 2’s recitation of a lease
22 occurs only in its preamble and this recitation is unnecessary to define the
23 invention. The preamble merely calls for a method “for configuring a
24 camera and paying for the lease.” None of the steps refer to the lease. To
25 the contrary, step (c) calls for debiting an account rather than executing a
26 lease.

1 If . . . the body of the claim fully and intrinsically sets forth the
2 complete invention, including all of its limitations, and the
3 preamble offers no distinct definition of any of the claimed
4 invention's limitations, but rather merely states, for example,
5 the purpose or intended use of the invention, then the preamble
6 is of no significance to claim construction because it cannot be
7 said to constitute or explain a claim limitation.

8 *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed.
9 Cir. 1999).

10 The Appellant further argues that the Admitted Prior Art and Kitigawa
11 fail to describe sending of the camera to a designee of the customer (Br. 8,
12 first paragraph). We disagree with the Appellant. The Admitted Prior Art
13 describes ordering a customized product over the Internet (FF 04) which
14 implicitly describes shipment of the product to a specific person or place.

15 The Appellant further contends that there is no motivation to combine
16 the Admitted Prior Art and Kitagawa (Br. 9, first paragraph). The Admitted
17 Prior Art describes customizing a product (FF 03) and Kitagawa describes a
18 camera system (FF 07). The Examiner concluded that one of ordinary skill
19 in the art would be motivated to combine these references in order to
20 increase profits by selling customized cameras via the Internet (Answer page
21 6, second paragraph). The Appellant responds that the combination of the
22 Admitted Prior Art and Kitagawa would only result in the sales of already
23 customized cameras (Br. 9, first paragraph). We do not find this argument
24 persuasive because the Admitted Prior Art describes the customizing of a
25 product (as discussed above) and thus the combination of the Admitted Prior
26 Art and Kitagawa would result in enabling a user to customize a camera
27 system according to the customer's desires as well.

1 Next we take up the arguments made specifically in support of claim
2 2. The Admitted Prior Art describes a “learn more” link depicted next to
3 selectable options that describes the details, which would include the
4 functionality of the options (FF 05). This therefore describes depicting the
5 functionality of desired features, and thus discloses this limitation of claim 2.

6 The Appellant has not sustained his burden of showing that the
7 Examiner erred in rejecting claim 2. We affirm the Examiner's rejections of
8 claims 2 and 3.

9

Group IV

11 The Appellant argues claims 4-6 and 16² as a group. Accordingly, we
12 select claim 4 as representative of the group. The Examiner rejected claim 4
13 for the reasons set forth in the rejection of claims 1 and 2. The Appellant
14 contends that claim 4 is distinguished from claims 1 and 2 because it recites
15 the additional feature of capturing the image using the configured camera
16 and forwarding such image for storage to a designated location. The
17 Appellant contends that neither the Admitted Prior Art nor Kitagawa
18 describe this feature (Br. 10, first complete paragraph).

19

² The Appellant contends that claims 4-6 and 16 depend on independent claims 2 or 9 (Br. 10, second paragraph); however, claims 4-6 and 16 depend on independent claim 2. None of these claims depend from independent claim 9.

1 We disagree with the Appellant. Kitagawa describes capturing
2 images using the Kitagawa camera system and forwarding the captured
3 images to a photo-lab to be printed (FF 08 and 10). This explicitly describes
4 this limitation of claim 4. The rejection of claim 4 is further sustained for
5 the same reasons set forth with respect to claim 2 above. We affirm the
6 Examiner's rejections of claims 4-6 and 16.

Group V

9 The Appellant argues claims 9-15 as a group. Accordingly, we select
10 claim 9 as representative of the group. The Examiner rejected claim 9 for
11 the same reasons set forth in the rejection of claim 1. Claim 9 recites the
12 method steps of 1) establishing a service user account that specifies the
13 selected service that the designee can use and 2) storing in the camera, a
14 service identifier corresponding to the service user account³. The Appellant
15 contends that neither the Admitted Prior Art nor Kitagawa describe these
16 features (Reply Brief page 1, second complete paragraph).

17 The argument with respect to establishing a service account was found
18 to be persuasive of Examiner err in the rejection of method claim 1, and
19 therefore the Appellant has similarly sustained its burden of showing that the
20 Examiner erred in rejecting claims 9-15 under 35 U.S.C. § 103(a) as
21 unpatentable over the Admitted Prior Art and Kitagawa.

³ This limitation in claim 9 differs from that of claim 17. Claim 17 recites an apparatus that includes a memory. This memory requires only the capacity for storing a service identifier. Claim 9 is a method claim that has a step requiring the actual performance of storing the service identifier.

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 2-6 and 16-19, but has sustained his burden of showing that the Examiner erred in rejecting claims 1 and 9-15.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 17-19 under 35 U.S.C. §102(b) as anticipated by Kitagawa is affirmed.
- The rejection of claims 1 and 9-15 under 35 U.S.C. §103(a) as unpatentable over Admitted Prior Art in view of Kitagawa is reversed.
- The rejection of claims 2-6 and 16 under 35 U.S.C. §103(a) as unpatentable over Admitted Prior Art in view of Kitagawa is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

hh

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